REMARKS/ARGUMENTS

The office action of June 7, 2004 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1, 2, 4-11, 13-20 and 22-27 remain pending in this application. Claims 3, 12, and 21 have been canceled without prejudice or disclaimer.

Claim 17 has been amended to improve the clarity of the invention and to change the claim dependency.

Claims 1, 10 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,288,473 to Lathrop. Claims 1-4, 8-13, 18-21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 4,764,971 to Sullivan in view of U.S. patent no. 5,923,339 to Date et al. ("Date").[1] Claims 5-7, 14-16, 22 and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sullivan in view of Date and further in view of U.S. patent no. 5,140,647 to Ise et al. ("Ise"). Applicants respectfully traverse these rejections. Claim 17 has not specifically been rejected, but as amended is similar to claim 8, which was rejected over Sullivan and Date.

REJECTIONS BASED ON LATHROP

The action contends that Lathrop discloses all the elements of independent claims 1, 10 and 19. As amended, independent claim 19 calls for, among other features, a storage medium that stores each of the processed image segments *separately as each of the processed image segments arrives at the storage medium.* Claim 19 substantially incorporates, among other features, the subject matter of now canceled claim 21, which was not rejected over Lathrop. Accordingly, amended claim 19 is distinguishable from Lathrop. Similarly, amended claim 1 calls for, among other features, subject matter similar to that of now canceled claim 3, which was not rejected over Lathrop and amended claim 10 calls for, among other features, subject matter similar to that of now canceled claim 12, which was not rejected over Lathrop. Accordingly, amended independent claims 1 and 10 are distinguishable from Lathrop.

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1 While numbered paragraph 7, on page 4 of the action only identifies claims 1, 3-4, 10, 12-13, 19 and 21 as being rejected over Sullivan and Date, the discussion following makes clear claims 2, 8-9, 11, 18, 20 and 23 are also rejected over Sullivan and Date.

REJECTIONS BASED ON THE COMBINATION OF SULLIVAN AND DATE

The action contends that Sullivan shows all the features of independent claim 19, but relies on memory units 102-105 shown in Fig. 1 of Date to show a storage medium that stores each of the plurality of processed image segments. As amended, claim 19 calls for, among other features, a storage medium that stores each of the processed image segments *separately as each of the processed image segments arrives at the storage medium.*

As discussed in the previous response, Sullivan at col. at col. 7, lines 22-28 explains that

The digital image processor performs the image processing on the image, using the image segment information, and supplies the *processed image* to an output device 22, such as a CRT display or hard copy generator in the case that the image processing was performed to improve the appearance of the image.

(Emphasis supplied). Notably, the processor 20 supplies the image rather than the image segments to the output device 22. Hence, Sullivan describes nothing more than providing the processed image signal to an output device and as such does not teach or suggest storing the *processed image segments separately as each of the processed image segments arrives at the storage medium* as recited in amended independent claim 19.

To overcome the aforementioned deficiency with respect to Sullivan, the action combines Sullivan with Date. In particular, the action alleges that it would have been obvious "to store processed image data prior to transferring the data to [a]n output device, such as a displaying device, as shown by Date" pointing to memory units 102-105 in Fig. 1 of Date. *Office Action,* paper no. 7 at page 5. The purported motivation for this combination asserted in the action is "to display the image based on data processed by the image processor and stored in a memory unit." Id.

Even assuming that it would have been obvious to store processed image data prior to transferring the data to a display device, the combination of Sullivan and Date would not have resulted in invention recited in amended independent claim 19. Indeed, the resulting combination, if proper would have included storing the processed image output from the processor 20 (of Sullivan) prior to transferring the processed image to the output device 22 (in Sullivan). Consequently, the combination would not have resulted in storing the *processed image*

segments separately as each of the processed image segments arrives at the storage medium as recited in claim 19.

Moreover, contrary to the action's assertion, one of ordinary skill in the art would not have been motivated to combine Date with Sullivan. The motivation alleged in the action does not express any reasoning why one would have wanted to modify Sullivan as Sullivan already processes an image and transfers the processed image to an output device for display. Indeed, it appears that the action has modified Sullivan with Date and then after the modification tried to use the result of the combination to provide the motivation for performing the modification. This is a classic example of impermissible hindsight. In view of the above, applicants submit that there is no reason, incentive or motivation to modify Sullivan with Date as alleged in the action. For this additional reason, the action has failed to establish a *prima facie* case of obviousness.

In light of the foregoing claim 19 is patentable over the combination of Sullivan and Date. Independent claims 1 and 10 as amended are similar to claim 19 in many respects. To the extent that the arguments asserted with respect to claim 19 apply to claims 1 and 10, these claims are believed to be allowable over the combination of Sullivan and Date. Also, claims 2, 4, 8 and 9, which ultimately depend from claim 1, claims 11, 13, 17 and 18, which ultimately depend from claim 10 and claims 20 and 23, which ultimately depend from claim 19, are patentable over the combination of Sullivan and Date for the same reasons as their ultimate base claim and further in view of the novel features recited therein. For example, claim 4 (and similarly claim 13) calls for the performing step to be performed on a first image segment when the storing step is being performed on a second image segment. The action points to elements 14, 20 and 22 in Fig. 1 of Sullivan in an attempt to show this feature. However, as discussed above the image processor 20 performs the image processing on the image, using the image segment information, and supplies the processed image to the output device 22. Since the processed image is provided to the output device 22, it necessarily follows that Sullivan does not perform processing of a first segment of an image while performing the operation of storing a second segment of the image called for in claim 4 (and similarly claim 13). Date does not remedy this defect of Sullivan.

REJECTIONS BASED ON THE COMBINATION OF SULLIVAN, DATE AND ISE

Ise which the action combines with Sullivan and Date to reject certain claims, which depend from clams 1, 10 and 19, does not overcome the aforementioned deficiencies of Sullivan and Date. Thus, claims 1, 2, 4-11, 13-20 and 22-27 are patentably distinct over the combination of Sullivan, Date and Ise for at least this reason, and further in view of the additional advantageous features recited therein.

The action combines Ise with Sullivan and Date to reject claims 5-7, 14-16, 22 and 24-27. Applicants submit that the action has failed to provide an appropriate incentive or motivation to combine Ise with Sullivan and Date. Namely, the action contends that it would have been obvious to combine Ise with Sullivan and Date "to create image segments that overlay one another". However, this statement appears to be nothing more than impermissible hindsight as no reason, explanation or motivation has been provided as to why one would have desired to create image segments that overlay one another in the system of Sullivan and Date. The action alleges that such overlap would have resulted in shortening the time taken for processing. While this may true in certain instances, it does not appear apply to the combination of Sullivan and Date. Specifically, since the processor 20 Sullivan processes the image using the image segment information, if image segments overlap one another, creating the image segments and processing the image would take more time, which generally is undesirable. Accordingly, even assuming, but not admitting, that the combination of Sullivan, Date and Ise would have resulted in the invention of any of the claims, one skilled in the art would not have been motivated to combine Sullivan, Date and Ise.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.
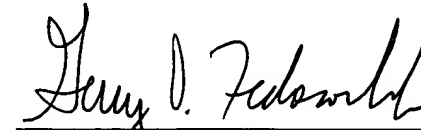
All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: September 7, 2004   By: _____

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